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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,199	10/16/2000	Billy P. Taylor	28150.7	2251

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EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT PAPER NUMBER

2157

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/690,199

Applicant(s)

TAYLOR, BILLY P.

Examiner

Hussein A. El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is responsive to amendment received on April 13, 2005. Claims 22-24 were newly added. Claims 1-21 were amended. Claims 1-24 are pending examination.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8, 15 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 1-8, 15 and 22 recite the limitation "it" in the claim. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson et al., U.S. Patent No. 6,486,895 (referred to hereafter as Robertson).

Robertson teaches the invention explicitly as claimed including a system and method for browsing electronic books through a webpage (see abstract).

As to claim 1, Robertson teaches a method performed by a computer system comprising:

storing an electronic version of a paper paper, wherein the digital version is displayable on a display device as a likeness of a hardcopy version of the paper (see col. 5 lines 37-col. 6 lines 57, electronic version of a book is stored); and

in response to content of a portion of the likeness forming a hyperlink reference within the digital version, wherein the hyperlink reference is associated with an operation of the computer device and with a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation and wherein the content is at least an alphanumeric character, a symbol, a term, a phrase and a reference (see col. 5 lines 37-col. 6 lines 57, the book is referenced as pages where each page correspond to a webpage with a separate link address).

As to claim 8, Robertson teaches a system comprising:

storing a version of a mass-produced printed paper (see col. 5 lines 37-col. 6 lines 57); and

forming a reference within the version, wherein the reference is a hyperlink associated with an operation and at least a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 5 lines 37-col. 6 lines 57)

As to claim 15, Robertson teaches a computer program product comprising a computer program processable by a computer system for causing the computer system to:

store a version of a mass-produced printed paper (see col. 5 lines 37-col. 6 lines 57); and

form a reference within the version, wherein the reference is a hyperlink associated with an operation and at least a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 5 lines 37-col. 6 lines 57) and

an apparatus from which the computer program is accessible by the computer system (see col. 5 lines 37-col. 6 lines 57).

As to claims 2, 9 and 16, Robertson teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the portion is displayable on the display device as a likeness of an advertisement within the paper (see col. 5 lines 37-col. 6 lines 57).

As to claims 3, 10 and 17, Robertson teaches the method, system and program of claims 2, 9 and 16 respectively wherein the forming comprises:

forming the reference within the version wherein the hyperlink specifies a website associated with the advertisement (see col. 5 lines 37-col. 6 lines 57).

As to claims 4, 11 and 18, Robertson teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the hyperlink specifies a website and wherein the operation includes displaying the website (see col. 5 lines 37-col. 6 lines 57).

As to claims 5, 12 and 19, Robertson teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes displaying a visual image in response to the file (see col. 5 lines 37-col. 6 lines 57).

As to claims 6, 13 and 20, Robertson teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes outputting audio signals in response to the file (see col. 5 lines 37-col. 6 lines 57).

As to claims 7, 14 and 21, Robertson teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the reference specifies a script and wherein the operation includes executing the script (see col. 5 lines 37-col. 6 lines 57 and fig. 13-15).

As to claims 22-24, Robertson teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises: the hyperlink specifies different portion of the likeness includes displaying the different portion (see col. 5 lines 37-col. 6 lines 57 and fig. 13-15).

***Response to Arguments***

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein Elchanti

June 16, 2005

  
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